

REMARKS

Applicants have carefully reviewed the Application in light of the Office Action mailed October 22, 2003. At the time of the Office Action, Claims 1-50 were pending in the Application. Applicants amend Claims 2-3, 7-9, 18-19, 23-25, 34-35, 39-41, and 50 to further clarify what Applicants consider to be the invention. As described below, Applicants believe all claims to be allowable over the cited references. Therefore, Applicants respectfully request reconsideration and full allowance of all pending claims.

Information Disclosure Statement (IDS)

Applicants submit an IDS with this Response for the Examiner's review and consideration. Applicants respectfully request that the Examiner formally indicate that the references were considered in the prosecution of the Application.

Section 103 Rejections

The Examiner rejects Claims 1-5, 7-8, 12-21, 23-24, 28-37, 39-40, and 44-49 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,628,767 issued to Wellner, et al. ("*Wellner*") in view of U.S. Patent No. 5,596,634 issued to Fernandez, et al. ("*Fernandez*"). Furthermore, the Examiner rejects Claims 6, 9-11, 22, 25-27, 38, and 41-43 under 35 U.S.C. §103(a) as being unpatentable over *Wellner* in view of *Fernandez* and further in view of U.S. Patent No. 6,556,670 issued to Horn ("*Horn I*"). In addition, the Examiner rejects Claim 50 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,178,237 issued to Horn ("*Horn II*") in view of *Fernandez*.

Wellner discloses a continuously updated web-based display of active callers on a conference call. (*Wellner*, Abstract). In order to gain access to a conference call, a caller must enter a personal identification number, such as over a voice connection, before being allowed to view a display containing the conference calls that a user may enter. (*Wellner*, Col. 2; Lines 52-58, Col. 7; Lines 12-15, Col. 8; Lines 24-27). A listing of the current users involved in the conference call is displayed to a user after the user has entered the conference. (*Wellner*, Col. 5; Lines 38-40). Information regarding the current speaker in a conference call may be displayed to the users. (*Wellner*, Col. 5; Lines 53-56).

Fernandez discloses a telecommunications system that allows an initial caller to access one of a plurality of conversations each relating to a particular topic. (*Fernandez*, Abstract). Upon the initial caller's selection of a desired discussion topic, the system connects the user to the conversation if such a conversation is in progress. (*Fernandez*, Col. 5; Lines 31-36). If there is no current conversation in progress for the selected topic, the call is terminated and the system may automatically call the initial caller back when another caller selects the same topic of conversation as the initial caller. (*Fernandez*, Col. 5; Lines 46-54).

In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. M.P.E.P. § 2143. In the present case, a *prima facie* case of obviousness cannot be maintained for at least two reasons.

First, Applicants respectfully argue that neither *Wellner*, *Fernandez*, *Horn I*, nor *Horn II* disclose a suggestion or motivation to combine the references. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination." M.P.E.P. § 2143.01. *Wellner*, *Fernandez*, *Horn I*, and *Horn II* fail to teach such a desirability.

The combination of prior art references without any evidence of a suggestion, teaching, or motivation to combine results in taking the present invention as a blueprint for piecing together prior art to defeat patentability. See *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1998). This is impermissible hindsight as the invention cannot be viewed with the blueprint drawn by the inventor. See *Interconnect Planning Corp. v. Feil*, 744 F.2d 1132, 1138 (Fed. Cir. 1985). In the present Office Action, the Examiner is merely using the present invention as a blueprint to piece together elements of various references when these references fail to suggest or motivate any combination between them.

In rejecting the present claims as obvious over the prior art, the Examiner should present evidence that suggests or motivates the modification, as is required by Federal Circuit case law. *See e.g., In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 (Fed. Cir. 1985). Evidence of teaching or suggestion of the combination of prior art references to achieve the claimed invention is "essential" to avoid hindsight. *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). In the present Office Action, the Examiner has merely stated that it would have been obvious to one skilled in the art at the time this invention was made to combine the elements disclosed in the cited references. However, the Examiner cites no language in the prior art that would suggest or motivate the combination of references. "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence" of a suggestion or motivation to combine references. *Dembiczak*, 175 F.3d at 999.

Second, assuming for the sake of argument, that a person of skill in the art would be motivated to combine *Wellner*, *Fernandez*, *Horn I*, and *Horn II*, these references fail to disclose at least some of the elements recited in each of Claims 1-50, as is described below.

Claims 1, 17, and 33 are Allowable over *Wellner* in view of *Fernandez*

Independent Claim 1 of the present application recites the following:

A method for controlling audio content during a multiparty communication session, comprising:
 prompting active participants of a multiparty communication session to identify themselves; and
 disabling media from a particular device from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.

Independent Claims 17 and 33 recite similar, although not identical, limitations.

Claim 1 recites "prompting active participants of a multiparty communication session to identify themselves." Claims 17 and 33 recite similar, although not identical, limitations. The Examiner states that *Wellner* discloses this limitation. (Office Action mailed 10/22/03, page 2, ¶2, citing *Wellner*, Col. 7; Lines 12-19). *Wellner* merely discloses that when a caller wishes to join a conference, the caller must enter a personal identification number before they

are allowed to view a display containing the conference calls that a user may enter. (*Wellner*, Col. 8; Lines 24-27). According to the disclosure in *Wellner*, at the time the caller is prompted to identify themselves (using a PIN number), the caller still has not become a member of the conference call. Rather, when the caller enters an identification of themselves, they are merely *attempting to join* the conference. Therefore, contrary to the limitations disclosed in Claim 1, and similarly, although not identically in Claims 17 and 33, the user in *Wellner* is not an *active participant* in a conference call at the time they are prompted to enter an identification. In addition, *Wellner* discloses that once a user has entered a conference, a listing of the participants in the conference is displayed to the user. (*Wellner*, Col. 5; Lines 37-39). However, *Wellner* fails to disclose whether or not the active participants are prompted to identify themselves in order to generate the list of active participants.

Furthermore, Claim 1 also recites "disabling media from a particular device from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session." The Examiner states that *Fernandez* discloses this limitation. (Office Action mailed 10/22/03, page 2, ¶2, citing *Fernandez*, Col. 1-2; Lines 60-7). *Fernandez* merely discloses that in the event that an initial caller selects a conference call topic that no other callers are participating in, the initial caller's call is terminated. (*Fernandez*, Col. 2; Lines 3-7). Thus, in *Fernandez*, there is no media to disable from a device which has no active identified participant, because a media stream is never established, as the initial caller's call is terminated due to the fact that there is not a conference call in progress. Furthermore, the device used by the initial caller also does not meet this limitation since it is *not* a device from which no active participant is identified. Therefore, *Fernandez* fails to disclose that media from a particular device is disabled from a particular device in which no active participant is identified, as is recited in Claim 1, and similarly, although not identically, in Claims 17, and 33. Furthermore, as described above, the Examiner has failed to show that there is a suggestion or motivation to combine the teachings of *Wellner* and *Fernandez*.

In addition, the Examiner states that other references teach disabling an inbound transmission on an inactive control channel link. (Office Action mailed 10/22/03, page 3, ¶2, citing U.S. Patent No. 6,091,714 issued to *Sensel*, et al.). *Sensel* is directed to a programmable digital switch system in which an inbound transmission can be disabled on an inactive link. (*Sensel*, Col. 42; Lines 35-43). Not only does *Sensel* fail to disclose "disabling media from a particular device from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session," as disclosed in Claim 1, and similarly, although not identically, in Claims 17 and 33, but the Examiner has failed to show that there is a suggestion or motivation to combine the teachings of *Sensel* with *Wellner* or *Fernandez*.

For at least these reasons, Claims 1, 17, and 33 are allowable over *Wellner* in view of *Fernandez* because a *prima facie* case of obviousness cannot be maintained. Therefore, Applicants respectfully request reconsideration and allowance of Claims 1, 17, and 33, as well as all claims that depend from these claims.

Claim 49 is Allowable over *Wellner* in view of *Fernandez*

Independent Claim 49 of the present application recites the following:

A method for handling on-hold endpoints in a conference call, comprising:
 receiving an audio stream from each of a plurality of participants to a conference call;
 receiving a control signal from a participant to the conference call indicating the conference call is receiving on-hold content from at least one on-hold endpoint;
 prompting each participant to send a reply to a prompt;
 receiving replies from active participants to the conference call;
and
 terminating media from devices associated with each participant not sending a reply.

Claim 49 recites, in part, "receiving a control signal from a participant to the conference call indicating the conference call is receiving on-hold content from at least one on-hold endpoint." The Examiner concedes that *Wellner* does not teach this limitation, but states that "putting a conference call on hold by the participant is well known..." (Office

Action mailed 10/22/03, page 4, ¶2). However, the Examiner has not indicated that receiving a control signal from a participant to the conference call indicating the conference call is receiving on-hold content from at least one on-hold endpoint, as recited in Claim 49, is well-known in the prior art, or that this limitation is disclosed by *Wellner*, *Fernandez*, or any other reference.

In addition, Claim 49 also recites "terminating media from devices associated with each participant not sending a reply." The Examiner indicates that *Fernandez* discloses this limitation. (Office Action mailed 10/22/03, page 4, ¶2, referring to the rejection of a similar limitation in Claim 1 based on *Fernandez*). However, as discussed above with respect to Claim 1, *Fernandez* merely discloses that in the event that an initial caller selects a conference call topic that no other callers are participating in, the initial caller's call is terminated. (*Fernandez*, Col. 2; Lines 3-7). Thus, in *Fernandez*, there is no media to terminate from devices associated with each participant not sending a reply, because a media stream is never established, as the initial caller's call is terminated due to the fact that there is not a conference call in progress.

For at least these reasons, Claim 49 is allowable over *Wellner* in view of *Fernandez* because a *prima facie* case of obviousness cannot be maintained. Therefore, Applicants respectfully request reconsideration and allowance of Claim 49.

Claim 50 is Allowable over *Horn II* in view of *Fernandez*

Independent Claim 50 of the present application recites the following:

A conference bridge, comprising:
an input buffer operable to receive and buffer audio streams generated by participants of a multiparty communication session;
a cross-connect operable to cross-connect an audio stream from each participant to conference output stream generators for remaining participants;
the conference stream output generator for each participant operable to combine each audio stream received from the cross-connect multiple independently controlled by the participant and to generate a conference output stream for the participant;
an output buffer operable to receive and buffer the conference output streams for transmission to the participant; and

an on-hold handler operable in response to a participant request to communicate with the participants, to identify active participants and to disable audio streams generated by devices associated with non-active participants.

Claim 50 recites, in part, "an on-hold handler operable in response to a participant request to communicate with the participants, to identify active participants and to disable audio streams generated by devices associated with non-active participants." The Examiner concedes that *Horn II* fails to disclose this limitation. (Office Action mailed 10/22/03, page 7, ¶4). However, the Examiner states that *Fernandez* discloses this limitation. (Office Action mailed 10/22/03, page 2, ¶2, citing *Fernandez*, Col. 1-2; Lines 60-7). As discussed above with reference to Claim 1, *Fernandez* merely discloses that in the event that an initial caller selects a conference call topic that no other callers are participating in, the initial caller's call is terminated. (*Fernandez*, Col. 2; Lines 3-7). Thus, in *Fernandez*, there is no audio stream to disable that is generated by devices associated with non-active participants, because an audio stream is never established, as the initial caller's call is terminated due to the fact that there is not a conference call in progress. Furthermore, *Fernandez* fails to disclose "a participant request to communicate with the participants," as recited in Claim 50, because at the time the initial caller selects a conference call topic that no other callers are participating in, there can be no participants since there is no multiparty communication to participate in. Therefore, *Fernandez* fails to disclose an on-hold handler operable in response to a participant request to communicate with the participants, to identify active participants and to disable audio streams generated by devices associated with non-active participants, as recited in Claim 50.

In addition, the Examiner states that other references teach disabling an inbound transmission on an inactive control channel link. (Office Action mailed 10/22/03, page 7, ¶4, citing U.S. Patent No. 6,091,714 issued to *Sensel*, et al.). As discussed above with reference to Claim 1, *Sensel* is directed to a programmable digital switch system in which an inbound transmission can be disabled on an inactive link. (*Sensel*, Col. 42; Lines 35-43). Not only does *Sensel* fail to disclose "an on-hold handler operable in response to a participant request to communicate with the participants, to identify active participants and to disable audio streams generated by devices associated with non-active participants," as disclosed in Claim

50, but the Examiner has failed to show that there is a suggestion or motivation to combine *Sensel* with *Horn II* or *Fernandez*.

For at least these reasons, Claim 50 is allowable over *Horn II* in view of *Fernandez* because a *prima facie* case of obviousness cannot be maintained. Therefore, Applicants respectfully request reconsideration and allowance of Claim 50.

Various Dependent Claims are Allowable over *Wellner* in view of *Fernandez*

Claims 2, 5, 7-8, 13, and 16 depend from, and include all of the limitations of, Claim 1, which is allowable for the reasons discussed above. Claims 18, 21, 23-24, 29, and 32 depend from, and include all of the limitations of, Claim 17, which is allowable for the reasons discussed above. Claims 34, 27, 39-40, 42, and 48 depend from, and include all of the limitations of, Claim 33, which is allowable for the reasons discussed above. In addition to the fact that Claims 2-3, 5, 7-8, 18-19, 21, 23-24, 34-35, 37, and 39-40 depend from allowable base claims, these claims are allowable because they each contain limitations not disclosed in *Wellner* or *Fernandez*.

For example, Claim 2, as amended, recites prompting the active participants to identify themselves in response to at least a request from one of the participants. Claims 18 and 34, as amended, recite similar, although not identical, limitations. The Examiner states that *Wellner* fails to disclose this limitation, but rather discloses that the "participants who join the conference with their web browser are prompted to identify themselves and their names are displayed." (Office Action mailed 10/22/03, page 3, ¶2). Based on the Examiner's concession that *Wellner* fails to disclose the present limitation and the Examiner's characterization of what *Wellner* does disclose, *Wellner* fails to disclose prompting the active participants to identify themselves *in response to at least a request from one of the participants*, as recited in amended Claim 2, and similarly, although not identically, in amended Claims 18 and 34.

For at least this additional reason, Claims 2, 18, and 34, as amended, are allowable over *Wellner* in view of *Fernandez* because a *prima facie* case of obviousness cannot be

maintained. Therefore, Applicants respectfully request reconsideration and allowance of Claims 2, 18, and 34 as amended.

In addition, Claim 5 recites disabling media from *each* device from which no active participant is identified. Claims 21 and 37 recite similar, although not identical, limitations. The Examiner states that *Fernandez* discloses this limitation. (Office Action mailed 10/22/03, page 2, ¶2, citing *Fernandez*, Col. 1-2; Lines 60-7). As discussed above with respect to Claims 1, 17, and 33, in *Fernandez*, there is no media to disable from a particular device which has no active participant because a media stream is never established, as the initial caller's call is terminated due to the fact that there is not a conference call in progress. Therefore, *Fernandez* fails to disclose disabling media from each device from which not active participant is identified, as is recited in Claim 5, and similarly, although not identically, in Claims 21, and 37.

For at least this additional reason, Claims 5, 21, and 37 are allowable over *Wellner* in view of *Fernandez* because a *prima facie* case of obviousness cannot be maintained. Therefore, Applicants respectfully request reconsideration and allowance of Claims 5, 21, and 37.

Furthermore, Claim 7, as amended, recites receiving a response to the prompt to the active participants to identify themselves from at least one active participant via a dual-tone multi-frequency (DTMF) command. Claims 23 and 39, as amended, recite similar, although not identical, limitations. Claim 8, as amended, recites utilizing adaptive speech recognition to identify responses from active participants to identify themselves. Claims 24 and 40, as amended, recite similar, although not identical limitations. The Examiner states that *Fernandez* discloses these limitations. (Office Action mailed 10/22/03, page 3, ¶2, citing *Fernandez*, Fig. 1, elements 112 and 120). *Fernandez* merely discloses that a caller can describe a conversation topic that the caller wishes to engage in by using a keypad or by issuing verbal inputs. (*Fernandez*, Col. 4; Lines 5-20, 34-44). However, *Fernandez* fails to disclose receiving a *response to the prompt to the active participants to identify themselves* from at least one active participant via a dual-tone multi-frequency (DTMF) command, as

recited in amended Claim 7, and similarly, although not identically, in amended Claims 23 and 39. Furthermore, *Fernandez* fails to disclose utilizing adaptive speech recognition to identify responses *from active participants to identify themselves*, as recited in amended Claim 8, and similarly, although not identically, in amended Claims 24 and 40.

For at least this additional reason, Claims 7-8, 23-24, and 39-40, as amended, are allowable over *Wellner* in view of *Fernandez* because a *prima facie* case of obviousness cannot be maintained. Therefore, Applicants respectfully request reconsideration and allowance of Claims 7-8, 23-24, and 39-40, as amended.

Claims 9, 25, and 41 are Allowable over *Wellner*, *Fernandez*, and *Horn II*

Claim 9, as amended, recites filtering out responses to the prompt to identify themselves from the active participants to prevent communication of the responses to the other devices in the multiparty session. The Examiner concedes that *Wellner* fails to disclose this limitation. (Office Action mailed 10/22/03, page 5, ¶3). Furthermore, the Examiner states that *Horn II* discloses a solution to prevent music-on-hold signals from being passed to conferees and that it would be obvious to a person of skill in the art to modify *Wellner* to include the elements of *Horn II* (Office Action mailed 10/22/03, page 5, ¶3, citing *Horn II*, Abstract). However, *Wellner*, *Fernandez*, and *Horn II* fail to disclose filtering out *responses to the prompt to identify themselves from the active participants* to prevent communication of the responses to the other devices in the multiparty session, as recited in amended Claim 9, and similarly, although not identically, in amended Claims 25 and 41. Furthermore, as discussed above, the Examiner has also failed to show a suggestion or motivation to combine or modify these references.

For at least this additional reason, Claims 9, 25, and 41 are allowable over *Wellner* in view of *Fernandez* because a *prima facie* case of obviousness cannot be maintained. Therefore, Applicants respectfully request reconsideration and allowance of Claims 9, 25, and 41.


CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

The required fee of \$180.00 is submitted herewith for the IDS and is believed to be correct. However, if this is not correct the Commissioner is hereby authorized to charge additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker & Botts, L.L.P.

Respectfully submitted,
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